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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,570	01/11/2002	Raj Jhanwar	MS#164036.2 (4933.1)	9456
321	7590	12/23/2004	EXAMINER	
SENNIGER POWERS LEAVITT AND ROEDEL ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			FOWLKES, ANDRE R	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,570

Applicant(s)

JHANWAR ET AL.

Examiner

Andre R. Fowlkes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 27-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/11/02, 9/2/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-16 and 27-39 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 27-39, drawn to a method of dynamically updating software stored on one or more installation media by analyzing hardware or software or both on the destination machine, and obtaining, from the one or more update media remote from the destination machine, update content specific to the analyzed hardware or software or both on the destination machine and , classified in class 717, subclass 173.
 - II. Claims 17-26, drawn to a method of dynamically updating software stored on one or more installation media, wherein the update content includes information identifying whether each of the one or more files has been verified to execute with the installation application program and including the step of storing state information for the installation application program, said state information gathered by the installation application program if an interruption occurs during execution of the installation application program, said state information used by the installation application program to resume execution classified in class 717, subclass 173.
3. The inventions are distinct, each from the other because of the following reasons:

4. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

5. In the instant case, invention I, as claimed does not require the particulars of the invention II, as claimed, because software is dynamically updated by invention I, without performing all of the techniques claimed in invention II. Invention II, as claimed, does not require the particulars of invention I, as claimed, because software is dynamically updated without performing all of the techniques claimed in invention I.

6. Invention I has separate utility such as dynamically updating software by analyzing hardware or software or both on the destination machine, and obtaining, from the one or more update media remote from the destination machine, update content specific to the analyzed hardware or software or both. Invention II has separate utility such as dynamically updating software by verifying whether each file is able to execute with the installation application and including the step of storing state information for the installation application program, to provide fault tolerance in case an interruption occurs during execution of the installation application program.

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7. During a telephone conversation with Jim Barta on 12/6/04 a provisional election was made without traverse to prosecute the invention of group I, claim 1-16 and 27-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-26 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

10. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claims 1-16 and 27-32, 35-39 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 and 25-35 of copending Application

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No. 10004073. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-16 and 27-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowler, U.S. Patent Application No. 2002/0174329.

As per claim 1, Bowler discloses **a method for dynamically updating software stored on one or more installation media for installation on at least one destination machine** (p. 2 col. L:8-10, "a method for automatically transitioning files (i.e. installing software) from a source computing system to a target computing system", and p. 9 col. R:18-21, "(The process may dynamically update software stored on an installation media, in such a way that the destination machine receives) new settings (i.e. software) 'calculated' from the old settings on a (installation media)"), **said method comprising:**

- **obtaining update content from one or more update media remote from the destination machine** (p. 9 col. R:20-24, "(The) process may also be used for extracting configuration settings (i.e. obtaining update content) from multiple ... computing systems (i.e. update media) that are local or remote, and conglomerating them"),

- **merging the update content at the destination machine with the software on the installation media prior to installing the software on the destination machine** (p. 9 col. R:20-24, "(The) process may also be used for extracting configuration settings (i.e. update content and software) from multiple ... computing systems that are local or remote, and conglomerating them").

As per claim 2, the rejection of claim 1 is incorporated and further, Bowler discloses that **obtaining update content from one or more media remote from the destination machine via a network** (p. 2 col. R:55-57 "including intermediate computing systems or computer networks (e.g. the Internet or an intranet, etc.) between the source computing system (i.e. remote media) and the target computing system (i.e. destination machine)").

As per claim 3, the rejection of claim 2 is incorporated and further, Bowler discloses that **the network is the Internet** (p. 2 col. R:55-57 "including intermediate computing systems or computer networks (e.g. the Internet or an intranet, etc.) between the source computing system (i.e. remote media) and the target computing system (i.e. destination machine)").

As per claim 4, the rejection of claim 1 is incorporated and further, Bowler discloses that **the update content includes at least one file** (p. 1 col. L:22-24 “a method and system for automatic transitioning of files among computer systems”).

As per claim 5, the rejection of claim 1 is incorporated and further, Bowler discloses that **the update content includes a patch** (p. 1 col. L:35-37 “updated versions of operating systems (i.e. patched versions), software applications and other improved features”).

As per claim 6, the rejection of claim 5 is incorporated and further, Bowler discloses that **the patch modifies the software on the installation media prior to installation on the destination machine** ((p. 1 col. L:35-37 “updated versions of operating systems (i.e. patched versions), software applications and other improved features”), and p. 9 col. R:20-24, “(The) process may also be used for extracting configuration settings (i.e. update content and software) from multiple ... computing systems that are local or remote, and conglomerating them (i.e. modifying them)”).

As per claim 7, the rejection of claim 1 is incorporated and further, Bowler disclose that the update content includes **a driver for controlling hardware on the destination machine** (p. 5 col. R:51-54 “(The system analyzes the hardware and/or software of the destination machine and) will not install configuration settings (and

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device drivers) for network applications that are not available on the (destination machine)").

As per claim 8, the rejection of claim 1 is incorporated and further, Bowler discloses that obtaining update content comprises:

- analyzing hardware or software or both on the destination machine, and obtaining, from the one or more update media remote from the destination machine, update content specific to the analyzed hardware or software or both on the destination machine (p. 5 col. R:51-54 "(The system analyzes the hardware and/or software of the destination machine and) will not install configuration settings (and software) for network applications that are not available on the (destination machine)").

As per claim 9, the rejection of claim 8 is incorporated and further, Bowler discloses **one or more computer readable media having computer-executable instructions for performing the method recited** (p. 18 col. R:14-15 "A computer readable medium having stored therein instructions for causing a processor to execute the method (of the invention)").

As per claim 10, the rejection of claim 1 is incorporated and further, Bowler discloses that **the software comprises operating system software or application**

program software or both (p. 1 col. L:35-37 “updated versions of operating systems, new software applications and other improved features”).

As per claim 11, the rejection of claim 1 is incorporated and further, Bowler discloses that **merging the update content with the software comprises one of the following: patching, replacing, and adding to the software on the one or more installation media** (p. 9 col. R:20-24, “(The) process may also be used for extracting configuration settings (i.e. update content, software and patches) from multiple ... computing systems that are local or remote, and conglomerating them”, and p. 5 col. R:57-59 “If the target computing system does not have TCP/IP installed, (then the system extracts that file from the update content)”).

As per claim 12, the rejection of claim 1 is incorporated and further, Bowler discloses **extracting at least one file from the update content** (p. 5 col. R:57-59 “If the target computing system does not have TCP/IP installed, (then the system extract that file from the update content)”).

As per claim 13, the rejection of claim 1 is incorporated and further, Bowler discloses that **pre-processing the update content in preparation for installation** (p. 5 col. R:47-50 “The (update content is pre-processed based on) ... the operating system (and) services available on the target computing system, (then applied to the target computing system)”).

As per claim 14, the rejection of claim 1 is incorporated and further, Bowler discloses that **the software comprises one or more files** (p. 1 col. L:22-24 "a method and system for automatic transitioning of files among computer systems"), **and further comprising searching the update content for each of the files, and searching the one or more installation media for each of the files not found in the update content** (p. 5 col. R:47-50 "The (update content is located and) ... applied to the target computing system)").

As per claim 15, the rejection of claim 14 is incorporated and further, Bowler discloses **specifying registry (settings) to automate installation of the updated software** (p. 5 col. R:28-45 "Exemplary configuration settings included in the (system, include) registry settings").

As per claim 16, the rejection of claim 14 is incorporated and further, Bowler discloses **one or more computer readable media having computer-executable instructions for performing the method recited** (p. 18 col. R:14-15 "A computer readable medium having stored therein instructions for causing a processor to execute the method (of the invention)").

As per claims 27-37, this is a computer readable media version of the claimed method discussed above, in claims 1-11 and 13, wherein all claimed limitations have

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also been addressed and/or cited as set forth above. For example, see Bowlers system for automatically transitioning files among computer systems (p. 2 col. L:3-32).

As per claims 38-39, this is a system version of the claimed method discussed above, in claims 1 and 10, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Bowlers system for automatically transitioning files among computer systems (p. 2 col. L:3-32).

Conclusion


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (571) 272-3697. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARF



TUAN DAM
SUPERVISORY PATENT EXAMINER